

## REMARKS

### 1. Summary of the Office Action

In the Office Action mailed April 6, 2009, the Examiner rejected claims 1, 4, 6-8, 11, 12, 15, 17-19, and 22 under 35 U.S.C. § 102(a) as being allegedly anticipated by Schon (US Publication No. 2005/0071234), rejected claims 5, 9, 16, and 20 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Schon in view of Attia (US Publication No. 2002/0016750), and rejected claims 3 and 14 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Schon in view of Blossom (US Publication No. 2003/0019942).

### 2. Status of the Claims

Claims 1, 5, 7-9, 11-13, 16-20, and 22 are currently amended. Claims 4, 6, and 15 are currently canceled. Claims 23-26 are currently added. Therefore, currently pending are claims 1, 5, 7-9, 11-13, 16-20, and 22-26, of which claims 1, 7, 12, and 18 are independent, and the remaining are dependent.

### 3. Claim Rejections Under 35 U.S.C. § 102(a)

Claims 1, 7-8, 11, 12, 17-19, and 22 stand rejected under 35 U.S.C. § 102(a) as being allegedly anticipated by Schon (US Publication No. 2005/0071234). Applicants respectively traverse.

The Court of Appeals for the Federal Circuit has held that “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, the court has held that “the identical invention must be shown in as complete detail as is contained in the claim.” *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

In this case, the Schon reference fails to anticipate the currently claimed invention for at least the reason that each and every element of the invention as defined by the claims is not set forth, either expressly or inherently, in the Schon reference.

**A. The Schon reference fails to disclose “the first device comprises means configured to start communicating with the communication network responsive to receiving the RF signal from the RF chip.”**

Applicants note that the Examiner relied upon paragraphs [0083-0085] of the Schon reference to show the prior un-amended limitation requiring only that the first device comprised means to start communicating with the network or server after receiving the RF signal. Applicants have amended the limitation in claim 1, and the corresponding limitations of claims 7, 12, and 18, to clarify that the first device comprises means “configured to start communicating with the communication network responsive to receiving the RF signal from the RF chip.” (emphasis added).

The Examiner indicated in the last office action that the claimed “first device” is embodied in the phone 611 of Schon. Applicants note that the Examiner failed to indicate what portion of Schon was being relied upon to disclose the claimed “communication network” under control of the second party.

In any event, Applicants submit that Schon fails to disclose that the phone 611 beings communicating on a network under control of a second party different from a first party responsive to receiving an RF signal from an RF device under control of the first party.

For at least this reason, Applicants submit that the Schon reference does not disclose each and every element of the currently claimed invention as set forth in independent claims 1, 7, 12, and 18. Furthermore, for at least the reason that the remaining dependent claims inherit all of the limitations of their respective independent claims 1, 7, 12, and 18, Applicants submit that the

Schon reference fails to disclose each and every element of the remaining claims. Accordingly, Applicants respectfully request that the rejections be withdrawn, and that a notice of allowance be mailed allowing all pending claims.

**B. The Schon reference fails to disclose “the first device comprises means for sending an enabling ID to the RF chip, the enabling ID uniquely identifying the first device to the RF chip” (claims 1 and 12) or “the RF chip comprises means for sending an enabling ID to the first device, the enabling ID uniquely identifying the RF chip to the first device” (claims 7 and 18)**

Applicants note that the Examiner relied upon Schon’s disclosure of the phone device 611 transmitting a shopping list to the cart reader to disclose the un-amended version of this limitation. However, the claims, as amended, now clarify that the enabling ID uniquely identifies the first device (or the RF chip) so that the enabling ID may be used to properly compensate the first party. The identification of grocery list items is not equivalent to identifying the actual first device or RF chip itself.

For at least this reason, Applicants submit that the Schon reference does not disclose each and every element of the currently claimed invention as set forth in independent claims 1, 7, 12, and 18. Furthermore, for at least the reason that the remaining dependent claims inherit all of the limitations of their respective independent claims 1, 7, 12, and 18, Applicants submit that the Schon reference fails to disclose each and every element of the remaining claims. Accordingly, Applicants respectfully request that the rejections be withdrawn, and that a notice of allowance be mailed allowing all pending claims.

**C. The Schon reference fails to disclose “causing the first party to be financially compensated by the second party for the network communications of the first device triggered by the RF chip based on the enabling ID.”**

Applicants note that the Examiner relied upon Schon’s disclosure of the store being compensated for the purchase of the grocery items as reading on the above-recited claim limitation. However, the claims, as amended, now clarify that the first party (which controls the RF chip) is financially compensated by the second party (which controls the network communications), and that the first party is different than the second party.

Applicants submit that Schon fails to disclose a first device beginning network communications on a communication network responsive to receiving an RF signal from an RF chip, and furthermore fails to disclose a method or means for compensating the owner of the RF chip for the network communications on the communication network by the first device caused by the RF chip. The purchase of food at a grocery store is simply not equivalent to the currently claimed invention.

For at least this reason, Applicants submit that the Schon reference does not disclose each and every element of the currently claimed invention as set forth in independent claims 1, 7, 12, and 18. Furthermore, for at least the reason that the remaining dependent claims inherit all of the limitations of their respective independent claims 1, 7, 12, and 18, Applicants submit that the Schon reference fails to disclose each and every element of the remaining claims. Accordingly, Applicants respectfully request that the rejections be withdrawn, and that a notice of allowance be mailed allowing all pending claims.

#### **4. Conclusion**

Applicants respectfully submit that, in view of the remarks above, the present application, independent claims 1, 7, 12, and 18 are allowable for at least all of the reasons stated above. The remaining dependent claims are all dependent on these allowable independent claims and are therefore allowable for at least the reasons stated above.

If there are any matters that may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact Applicants' undersigned representative at (312) 913-0001.

Respectfully submitted,

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